

REMARKS

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented above, with an appropriate defined status identifier.

Claims 1-14 and 16 are pending in the application, with claim 1 being the independent claim. Claim 15 was cancelled by previous amendment. Claims 2, 3, 8-10, and 12 are withdrawn from consideration as being drawn to a nonelected invention.

No amendments have been made to the claims with the current Reply. The listing of the claims provided above is solely for the convenience of the Examiner.

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

I. The Information Disclosure Statement Issues

The Examiner alleges that Applicants' Information Disclosure Statement filed on May 11, 2005 fails to comply with 37 C.F.R. 1.98(a)(2), which requires a legible copy of each cited foreign patent document, and each non-patent literature publication. (Office Action, at page 2, lines 12-14.)

As explained at page 2 of Applicants' May 11, 2005 Information Disclosure Statement ("IDS"), Applicants did not provide copies of the four cited non-patent literature documents (Documents A5-A8) with the IDS because copies of these documents should have been provided to the US Patent and Trademark Office ("PTO") directly by the World Intellectual Property Organization under an exchange program between the PTO, the European Patent Office, and the Japanese Patent Office. However, to expedite prosecution of the current application, Applicants file concurrently with this Reply a Supplemental Information Disclosure Statement in which legible copies of Documents A5-A8 (renumbered as Documents C4-C7) are submitted.

The Examiner also alleges that Applicants' Information Disclosure Statement filed on February 23, 2007 fails to comply with 37 C.F.R. 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in the English language. (Office Action, at page 2, lines 17-20.)

Applicants respectfully direct the Examiner's attention to page 2 of the February 23, 2007 IDS, in which Applicants state that the relevance of each of the cited foreign language documents (Documents B5-B7) is described in the present specification. To expedite prosecution of the current application, however, Applicants again cite the three foreign language document (renumbered as Documents C1-C3) in the Supplemental IDS filed concurrently with this Reply, and also explicitly provide a brief statement of relevance for each document.

II. The Rejection of the Claims Under 35 U.S.C. § 103

The Examiner rejects claims 1, 7, 13, 14, and 16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hiraga *et al.*, U.S. Pat. No. 4,590,189 ("Hiraga"). Applicants respectfully traverse this rejection.

Specifically, the Examiner contends that Hiraga teaches four compounds (compounds 4, 10, 23, and 24 in Table 2, at columns 15-20) that allegedly render Applicants' claimed compounds obvious. (Office Action, at page 3, lines 15-17.) According to the Examiner, the only difference between compounds 4, 10, 23, and 24 of Hiraga and Applicants' claimed compounds is the value of the variable R₁, which is hydrogen in the Hiraga compounds and methyl in Applicants' claimed compounds, and "[h]ydrogen vs. Methyl is not considered a patentable advance absent evidence of superior, unexpected results." (Office Action, at page 3, lines 17-19 and 22-24.) The Examiner states that "[a]pplicant advances no evidence of superior or unexpected results." (Office Action, at page 3, lines 21-22.)

Applicants respectfully submit herewith a Declaration under Rule 1.132 by Masakazu Yoshimura ("Yoshimura Declaration"). The Yoshimura Declaration describes the results of experiments in which compounds similar to the Hiraga compounds in which R₁ is hydrogen (Compounds 1 and 2) and corresponding compounds of the present invention in which R₁ is

methyl (Compounds 3 and 4) are tested for anesthetic effects, measured as loss of righting reflex (“LRR”) and time of induced sleep (“sleep time”) in four-week-old mice. The Declaration indicates that Compounds 3 and 4 exhibit anesthetic effects, while Compounds 1 and 2 exhibit no anesthetic effects. Thus, the anesthetic effects of Compounds 3 and 4 of the present invention, in which R₁ is methyl, constitute evidence of superior and unexpected results over the corresponding compounds disclosed in Hiraga in which R₁ is hydrogen.

The Examiner also alleges that the Hiraga compounds “are being used as muscle relaxants (also known as tranquilizers or sedatives) (column 9, line 30-column 10, line 13) . . .” (Office Action, at page 3, lines 24-25.)

Applicants respectfully note that, at column 9, line 30-column 10 line 13, Hiraga teaches that the disclosed compound displays strong antianxiety effect(s) (col. 9, ln. 33) and anticonvulsant activity (col. 10, ln. 3), and that its “hypnotic and muscle relaxing effects” are *side effects* that are *very weak* compared with the benzodiazepine antianxiety drugs on the market (col. 9, lines 38-40) (emphasis added). Thus, Hiraga teaches away from the use of the disclosed compounds as muscle relaxants and, therefore, as tranquilizers or sedatives.

Applicants submit that the rejection of claims 1, 7, 13, 14, and 16 under 35 U.S.C. § 103(a) has been overcome and respectfully request that the Examiner withdraw the rejection.

III. The Rejection of the Claims Under 35 U.S.C. § 102

The Examiner rejects claims 1 and 7 under 35 U.S.C. § 102(b) as allegedly being anticipated by Baik *et al.*, WO 98/42666 (“Baik”). Applicants respectfully traverse this rejection.

Specifically, the Examiner states that “Baik et al. teach example 31 (page 49), which anticipates claims 1 and 6 because all instances of variable R₁ and L are methyl, variable X is oxygen, and variable R₂ is 3-methoxy-4-oxy-cyclopentyl-benzene. Claim 6 is anticipated because variable R₂ is a substituted phenyl ring.” (Office Action, at page 4, lines 10-14.)

Applicants respectfully assert that the compound of Example 31 in Baik is excluded from the claims 1 and 6 of the instant application because claim 1 of the current application recites the proviso that “provided that when R₂ is phenyl, the 3- and 4-positions of the phenyl moiety are not substituted by alkoxy groups at the same time”. In the compound of Example 31 of Baik, the group at the R₂ position is 3-methoxy-4-oxocyclopentyl-benzene, which is a phenyl ring substituted at the 3- and 4- positions with alkoxy groups (methoxy and oxocyclopentyl). Thus, the compound of Example 31 is excluded from pending claims 1 and 6 and does not anticipate these claims.

Applicants submit that the rejection of claims 1 and 6 under 35 U.S.C. § 102(b) has been overcome and respectfully request that the Examiner withdraw the rejection.

IV. Allowable Subject Matter

The Examiner objects to claims 4, 5 and 11 as being dependent upon a rejected base claim, but states that these claims “would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” (Office Action, at page 4, lines 16-18.)

Applicants wish to thank the Examiner for considering claims 4, 5 and 11 allowable. Applicants have chosen not to amend these claims into an independent format in light of their remarks in this Reply, which Applicants respectfully believe are sufficient to overcome the Examiner’s rejections of the base claims.

CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date February 25, 2008

By Ann E. Summerfield

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5571
Facsimile: (202) 672-5399

Ann E. Summerfield
Attorney for Applicants
Registration No. 47,982